

Notice of Allowability

Application No.

10/802,359

Examiner

William J. Allen

Applicant(s)

SILBERSTEIN ET AL.

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Examiner's Amendment and response filed 12/7/2006.
2. ☒ The allowed claim(s) is/are 21-40.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.


Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date 20070212.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 20070212.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

DETAILED ACTION

Prosecution History Summary

Claims 1-20 have been previously cancelled.

Claims 21-45 were pending per Applicant's amendment filed 12/07/2006.

Claims 41-45 have been canceled per the below Examiner's Amendment.

Claims 21-40 are allowed for at least the reasons below.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Matt Dennehy on 2/9/07.

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The application has been amended as follows:

In the Claims

Claims 1-20 (Cancelled).

21. (Currently Amended) A method for selling jewelry to a customer, the customer acting as a gift giver, the method comprising the steps of:

providing a selection of rough stones to a customer;

informing the customer about available options on cuts and sizes of stones that may be yielded from the selection of rough stones;

allowing choosing, by the customer, to choose a specific rough stone from the selection of rough stones based on a specific available option chosen by the customer;

cutting the specific rough stone into at least two cut stones as per the specific available option chosen by the customer, the at least two cut stones including a major stone and at least one remainder stone;

selling the cut stones to the customer;

allowing presenting, by the customer, to present the cut stones to at least two recipients, whereby the customer and the recipients have a specific sentimental relationship, the cut stones yielded from the specific rough stone being symbolic of the sentimental relationship.

22. (Previously Presented) The method of selling jewelry as claimed in claim 21 wherein the customer and one of the recipients are same person.

23. (Previously Presented) The method of selling jewelry as claimed in claim 21 wherein the customer is a parent and the recipients are at least two children of the parent.

24. (Previously Presented) The method of selling jewelry as claimed in claim 21 wherein the customer is a grandparent and the recipients are at least two grandchildren of the grandparent.

25. (Previously Presented) The method of selling jewelry as claimed in claim 21 whereby the selection of rough stones have stones of different karat, color and clarity.

26. (Previously Presented) The method of selling jewelry as claimed in claim 21 further comprising the step of determining a cutting configuration for the specific rough stone.

27. (Previously Presented) The method of selling jewelry as claimed in claim 26 whereby the cutting configuration is any possible type of cut for a gemstone.

28. (Previously Presented) The method of claim 21 further comprising the step of:
mounting the at least two stones to at least two pieces of jewelry, the pieces of jewelry being presented to the recipients.

29. (Previously Presented) The method of claim 22 wherein the specific sentimental relationship is husband and wife.

30. (Previously Presented) The method of claim 22 wherein the specific sentimental relationship is a life partner.

31. (Previously Presented) The method of claim 22 wherein the specific sentimental relationship is parent and child.

32. (Previously Presented) The method of claim 22 wherein the specific sentimental relationship is siblings.

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33. (Previously Presented) The method of claim 22 wherein the specific sentimental relationship is persons engaged to be married.

34. (Previously Presented) The method of claim 21 wherein the step of providing a plurality of rough stones to a customer is presented over the Internet.

35. (Previously Presented) The method of claim 21 wherein the step of providing a plurality of rough stones to a customer is presented at a retail store.

36. (Previously Presented) The method of claim 21 wherein the step of providing a plurality of rough stones to a customer is presented in a catalogue.

37. (Previously Presented) The method of claim 21 wherein the specific rough stone is a diamond.

38. (Previously Presented) The method of claim 21 wherein the specific rough stone is a ruby.

39. (Previously Presented) The method of claim 21 wherein the specific rough stone is an emerald.

40. (Currently Amended) The method of claim + 21 wherein the specific rough stone is a sapphire.

Claims 41-45 (Cancelled).

ALLOWABLE SUBJECT MATTER

The following is an examiner's statement of reasons for allowance:

Regarding claim 21, the prior art made of record neither anticipates nor fairly and reasonably teaches "choosing, by the customer, a specific rough stone from the selection of rough stones based on a specific available option chosen by the customer and cutting the specific rough stone into at least two cut stones as per the specific available option chosen by the customer, the at least two cut stones including a major stone and at least one remainder stone".

Claims 22-40 depend from allowable claim 21 and are thereby allowable for at least the reasons above regarding claim 21.

The most remarkable prior art of record is CA 2343448 (listed as PTO 892 reference N) to Tcharnyl (herein referred to as CA234). CA234 teaches a new marketing principal for customized jewelry specifically directed to sets of two or more loose gemstones or jewelry articles containing gemstones. More specifically, CA 234 is relevant in that it provides a means for selling two or more gemstones (or jewelry articles containing two or more gemstones) that have been cut from the same rough stone in order to provide a higher emotional value to the article. Unlike the present application, CA 234 provides goods comprising two or more polished gemstones or other precious stones cut from the same rough stone. Though CA 234 does provide for the sentimental aspects of the instant application, it is clear that CA 234 is fundamentally different as it is not directed to the selection, by the customer, of a specific rough stone and having the stone cut according to a specific option designated by the customer.

US Patent/PG Pubs

- **US 20050197951 to Tolkowsky** teaches a method of selling polished gemstones or jewelry pieces set with polished gemstones, the piece of jewelry being accompanied with a rough stone which was part of the same unique piece of rough from which the polished gemstone was produced. Tolkowsky, however, does not anticipate or render obvious the above mentioned limitations.
- **US 5950178 to Borgato** teaches a data processing system storing data from sellers on stones to be sold based upon various characteristics such as weight, color, etc. Though Borgato teaches the selling of both cut and uncut stones to willing buyers, Borgato fails to anticipate or render obvious the above noted limitations.

Foreign Patent Documents

- **CA 2343448 to Tcharnyl** teaches a new principal in marketing jewelry including marketing gemstones or jewelry containing gemstones, wherein the gemstones originated from the same rough stone. Tcharnyl, however, fails to anticipate or render obvious the above noted limitations.
- **JP 01017605 to Freilich** teaches double-faced personal ornaments manufactured to hold rough or unfinished stones/jewelry pieces such as diamonds. Freilich, however, fails to anticipate or render obvious the above mentioned limitations.

Non-Patent Literature

- **PTO 892 reference U** teaches market analysis for diamond sales where high-end independent retailers and internet retailers outperformed the remainder of the market. PTO 892 U, however, fails to anticipate or render obvious the above noted limitations.
- **PTO 892 reference V** teaches the Atlantis ring, a wedding ring yielded from the same material and created in the same mold. PTO 892 V, however, fails to anticipate or render obvious the above noted limitations.
- **PTO 892 reference W** teaches the website BlueNile.com for selling customized jewelry articles. PTO 892 W is directed to the sale of pre-cut, cataloged stones and fails to anticipate or render obvious the above mentioned limitations.
- **PTO 892 reference X** teaches the lesbian lover ring, available in a two piece set as a wedding ring, promise ring, or the like. The two piece set is designed to fit together as a symbol of commitment. PTO 892 X, however, fails to anticipate or render obvious the above noted limitations.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Examiner's Comments

In the Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings submitted contain hand drawn elements and improper shading that may affect clarity once reproduced (see Fig. 2). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
February 12, 2007


MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600